

claims 1, 2, 7, 9, 17 and 20 have been amended, and claim 21 has been added to more appropriately describe and claim the invention. Thus, claims 1-21 remain pending. The above amendment with the following remarks are submitted to be fully responsive to the Official Action. Reconsideration of this application in light of these remarks, and allowance of this application are respectfully requested.

I. Specification

Applicants have corrected minor typographical errors.

II. Rejection of Claims Under 35 U.S.C. § 102(b)

On page 2 of the Official Action, the Examiner rejected claims 1-20 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 6,084,989 to Eppler (hereinafter, Eppler).

The present invention as recited in independent claim 1 is directed to a system for automatically manipulating or annotating a second map when a first map is manipulated or annotated, the system comprising: a map display; a map processing platform in communication with the map display; a storage platform coupled to the map processing platform; and a user interaction device coupled to the map processing platform.

In contrast, Eppler discloses a method and system for determining offset errors between line and pixel coordinates of landmarks in a digitized image generated by an imaging system (satellite), and line and pixel coordinates predicted by a mathematical model of the imaging system using landmark geodetic coordinates on the Earth. In operation, a digitized image generated by a satellite is processed to extract a patch of the image containing a particular landmark. The absolute coordinates of the upper left

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corner of the patch of the image are determined (col. 2, lines 13-15.) A list of coordinates for the corresponding landmark stored in the database is processed through a mathematical model of the imaging system to generate absolute coordinates of the boundary pixels of the landmark (col. 2, lines 20-24.) Software algorithms generate row and column offset error values indicative of the offset between the actual position of the landmark and the desired position of the landmark in the image (defined by the landmark geodetic coordinates stored in the database) (col. 2, lines 32-37.) Alternatively, an operator may use a cursor on an interactive image display to designate the line-pixel address associated with geodetic coordinates of salient features marked on hardcopy maps. The landmark position system processes the supplied data to generate line and pixel error values corresponding to the offset errors. The errors are supplied to an attitude tracking system which generates orbit and attitude prediction coefficients for the satellite (col. 5, lines 18-25.)

Eppler fails to disclose at least a capability to manipulate or annotate a second map after a first map is manipulated or annotated. In Eppler, annotations made to a first map are not later placed onto a second map. Even assuming *arguendo* that Eppler could be modified to manipulate or annotate a second map after a first map is manipulated or annotated, the modification would not be responsive to the problem sought to be addressed by Eppler (i.e., to generate orbit and attitude prediction coefficients for the satellite.)

Anticipation under 35 U.S.C. §102(b) requires that each and every claim limitation be disclosed by the applied reference. Eppler does not teach each and every claim limitation of claims 1-20 and therefore, as a matter of law, cannot anticipate these

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claims. That is, Eppler does not teach the process of manipulating or annotating a second map after a first map is manipulated or annotated.

In the Official Action, the Examiner recognizes that many of the features claimed are not disclosed, taught, or suggested by Eppler, and he alleges that they all would have been inherent in Eppler. Applicants respectfully disagree.

To properly show that an element not disclosed in Eppler is, in fact, inherent in that reference, the Examiner should cite extrinsic evidence, such as an extra reference, that describes the inherent element. See M.P.E.P. § 2131.01(III) (8<sup>th</sup> ed. 2001). "Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be recognized by persons of ordinary skill." Id. Inherency, however, may not be established by probabilities or possibilities. See M.P.E.P. § 2163.07(a) (8<sup>th</sup> ed. 2001).

In this case, the Examiner provides no reference or other evidentiary basis to support the inherency allegation. Even if the Examiner provided a second reference that discloses the process of manipulating or annotating a second map after a first map is manipulated or annotated, as recited in claim 1, the teachings of the second reference could not be inherent in Eppler, as would be necessary in order to establish anticipation of the subject matter of the claim, because the features of manipulating or annotating would frustrate the purpose for which Eppler was intended.

Even though the cited reference fails to reach the teachings of Applicants' device, Applicants have amended claims 1, 2, 7, 9, 17 and 20 to more appropriately describe Applicants' invention, and added new claim 21 to more fully cover the subject matter of Applicants' invention. Applicants contend that the claims as amended, still patentably

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distinguish over the prior art. Therefore, the rejection of independent claims 1, 17, 18 and 20 under 35 U.S.C. §102(b) as anticipated by Eppler should be withdrawn. The rejection of dependent claims 2-16 and 19 should also be withdrawn as they depend on allowable subject matter as recited in the respective independent claims from which they directly or indirectly depend. Claim 21 depends from allowable claim 1, and is therefore allowable as filed.

In view of the foregoing, it is submitted that the cited prior art fails to teach or suggest Applicant's claimed invention. Applicants respectfully assert that the present application is in condition for allowance and request a notice to that effect.

Attached hereto is a marked-up version of the changes made to the claims by this amendment. The attached page is captioned "Version with markings to show changes made." Deletions appear as normal text surrounded by [ ] and additions appear as underlined text.

If any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this response, and not requested by attachment, such extension is hereby requested. If there are any fees due under 37 C.F.R. § 1.16 or 1.17 that are not enclosed, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge those fees to our deposit account 06-0916.

Respectfully submitted,

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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE SPECIFICATION:**

Please amend the second full paragraph on page 7 of the specification to read as follows:

Map image synchronization is a method whereby two map images can be made to show the same geographic region at all times, maintaining this synchronization even after one of the images is panned, zoomed, scrolled, or otherwise caused to display a different region. Whenever such a change occurs on one map, the system causes the same change to occur on the other map as well. In this way, the two images continue to display the same region, [wit out] without the need of manually adjusting both maps. In addition the synchronization system allows annotations to be placed on either map at specified geographic locations, and causes a matching annotation to appear on the other map in the corresponding location.

Please amend the paragraph extending from page 10, line 26 to page 11, line 7, of the specification to read as follows:

Certain minor adjustments are required in the display if a region is selected which is not entirely present on one or more of the maps, or if the aspect ratios of the screen display areas devoted to each map are different. In the first case, the system attempts a "best fit" when one map

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selection included area not found in the other map, and simply displays blank additional area to fill the missing region, so that the map windows will be filled and the synchronization of the images maintained. In the second case, the other map can be scaled to reflect the same area, or alternatively one or more of the map windows may be equipped with scroll bars, so that the effective dimensions of the map windows become identical.

**IN THE CLAIMS:**

Please amend claims 1, 2, 7, 9, 17 and 20, as follows:

1. (Amended) A system for automatically manipulating or annotating a second map when a first map is manipulated or annotated, the system comprising:
  - a map display;
  - a map processing platform in communication with the map display,

wherein said map processing platform is adapted to:

  - receive a user annotation at a first location on a first map; and
  - update a second map with the user annotation at a location on the

second map that corresponds to said first location;

  - a storage platform coupled to the map processing platform; and
  - a user interaction device coupled to the map processing platform.
2. (Amended) The system of claim 1 wherein the map display is enabled to display a first map in a first area of the map display and to display a second map in a second area of the map display.

7. (Amended) The system of claim 1 wherein the storage platform comprises ~~[cached]~~ cached memory.

9. (Amended) The system of claim 1 wherein the storage platform comprises ~~[non-cached volatile storage]~~ random access memory.

17. (Amended) ~~[A data signal comprising a data structure]~~ An apparatus capable of manipulating a map [manipulation, by] comprising:

means for determining a boundary of a geographic region of a first map;  
means for converting the boundary of the geographic region of the first map into a corresponding boundary of a second map; and  
means for configuring the boundary of the second map for display.

20. (Amended) A computer readable medium [whose contents cause a correlation of] containing instructions executable by a computer to perform a method of correlating a map annotation between a first map and a second map, the second map being geographically substantially similar to the first map [by], the method comprising:

detecting an annotation entry on the first map;  
associating the annotation entry with a set of first map coordinates;  
associating the set of the first map coordinates with a set of second map coordinates; and  
enabling the display of the annotation entry on the second map.